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Henry P Sartorio Lawrence Berkeley Nat'l Lab Patent Dept One Cyclotron Road MS 90 1121 Berkeley, CA 94720			HENDRICKSON, STUART L	
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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 06102004

Application Number: 09/518,989

Filing Date: March 03, 2000

Appellant(s): PISKOTI ET AL.

David Aston
For Appellant

EXAMINER'S ANSWER

MAILED
JUN 15 2004
GROUP 1700

This is in response to the appeal brief filed 3/15/04.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

Due to the withdrawal of certain rejections, claims 1-5, 10 are on appeal. Claims 6-9 are considered allowed.

(4) Status of Amendments After Final

The statement in the Brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: The sole issue is whether claims 1-5, 10 are patentable over Stankevich et al. Note that there is one rejection, not two, over Stankevich. The rejections under '112 first paragraph and over Service/Nature article are withdrawn.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims under appeal do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

Stankevich et al., 'Polyhedral Carbon Clusters C_{36+12n} (n>0) And Their Hydrocarbon Analogs As Predecessors of (6,0)- Tubular Structures' in Molecular Materials vol. 10 pp. 169-174 (1998).

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-5, 10 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Stankevich et al.

The reference teaches C₃₆ on pg. 172. As its properties are reported, it appears to have been made and isolated.

(11) Response to Argument

The argument that Stankevich is theoretical is not persuasive, as some experimental work is described. At the bottom of pg. 171 is noted some actual physical uses, although not for C36 explicitly. It is not seen how the calculations shown in the article could arrive at the physical properties quoted, thus it appears that C36 was characterized, and thus synthesized. That Stankevich does not detail the synthesis method is not persuasive.

It is noted that a 'coating' does not impart any additional limitation; it appears to be merely a statement of intended use.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



SLH
June 11, 2004

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PRIMARY EXAMINER

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